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Notice of Allowability

Application No.

09/745,883

Examiner

Chih-Min Kam

Applicant(s)

DEMUTH ET AL.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/27/04.
2. ☒ The allowed claim(s) is/are 1-8, 14 and 16-22.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 14 (6/13/2002).
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>20050301</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with John Serio on March 1, 2005.

Examiner's Amendments to the Specification:

Please replace the paragraph of the specification beginning at page 8, lines 27-30 with the following paragraph:

According to a preferred embodiment of the present invention, compounds are used in which B is proline, hydroxyproline, thiazolidinecarboxylic acid, dehydro-proline, pipecolic acid, 2- or 3-azetidinecarboxylic acid, or 2-aziridinecarboxylic acid, with proline and hydroxyproline being especially preferred.

Examiner's Amendments to the Claims:

Claims 2, 16 and 17 have been amended as follows:

2. (Currently amended) Compounds according to claim 1, wherein B is selected from the group consisting of proline, hydroxyproline, thiazolidinecarboxylic acid, dehydroproline, pipecolic acid, 2-azetidinecarboxylic acid, 3-azetidinecarboxylic acid and 2-aziridinecarboxylic acid.

16. (Currently amended) Compounds of inhibitors of the enzymatic activity of dipeptidyl peptidase IV (DP IV), which compounds have the general formula A-B-C, wherein

A is an Amino acid,

B is a chemical bond between A and C or is an amino acid, and

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C is an inhibitor of DP IV wherein said inhibitor is a dipeptidyl cyanide.

17. (Currently amended) Compounds according to claim 16, wherein B is selected from the group consisting of proline, hydroxyproline, thiazolidinecarboxylic acid, dehydroproline, pipercolic acid, 2-azetidinecarboxylic acid, 3-azetidinecarboxylic acid and 2-aziridinecarboxylic acid.

The oath or declaration filed July 30, 2004 is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because it lists the foreign application DE 19828114.5 and PCT/EP99/04381 under 35 U.S.C. § 119(a)-(d), it should claim foreign priority benefits of DE 19828114.5 under 35 U.S.C. § 119(a)-(d), and claim benefits of PCT/EP99/04381 under 35 U.S.C. § 120.

Applicant is required to send a 312 amendment to correct the continuation data at page 1, lines 9-10 of the specification.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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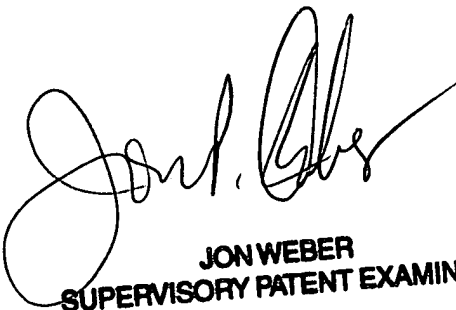
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Chih-Min Kam, Ph. D. *CMK*

Patent Examiner

CMK

March 1, 2005



JON WEBER
SUPERVISORY PATENT EXAMINER